

REMARKS**Summary of the Office Action**

Claims 31-32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 5-6 and 31-32 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 5,785,585 to *Manfredi et al.* (“*Manfredi*”).

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Manfredi* in view of U.S. Patent No. 6,116,997 to *Hakomori et al.* (“*Hakomori*”).

Summary of the Response to the Office Action

Applicants propose canceling claims 31 and 32, without prejudice or disclaimer. Accordingly, claims 1 and 3-6 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 31-32 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 31 and 32 have been canceled without prejudice or disclaimer. Applicants respectfully submit that this rejection is moot in light of the current cancellation of claims 31 and 32. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-3, 5-6 and 31-32 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by *Manfredi*. Claims 31 and 32 are canceled. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Manfredi* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that *Manfredi* does not teach or suggest at least "said dressing tool having a substantially rectangular dressing surface for contacting the working surface of working tool," as recited in independent claims 1, 5, and 6." At least these features are not disclosed or taught by *Manfredi*.

Manfredi discloses a method of conditioning a polishing pad. The apparatus consists of a wedge-shaped conditioning plate (40, 70). See Fig. 1 and the Abstract of *Manfredi*. However, *Manfredi* fails to teach or suggest at least the above-mentioned features of claims 1, 5, and 6. Contrary to the Office Action, the arcuate dressing tool in *Manfredi* is not "substantially rectangular" and even though the pie-shaped dressing conditioning plate could possibly be reshaped to be substantially rectangular, that does not make it so. See col. 5, line 64 through col. 6, line 16 of *Manfredi*. In fact, the conditioning plate (40, 70) in *Manfredi* cannot be "substantially rectangular" as suggested in the Office Action because a shape other than a wedged-shaped conditioning plate would destroy the invention. See col. 6, lines 14-16 of *Manfredi*. Thus, *Manfredi* cannot and does not disclose these features. As such, it cannot anticipate the invention recited in amended claims 1, 5, and 6.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Manfredi* does not teach or suggest each feature of independent claims 1, 5, and 6.

Additionally, Applicants respectfully submit that dependent claim 3 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Manfredi* in view of *Hakomori*". Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Applicants respectfully submit that *Hakomori* does not make up for the deficiencies identified in *Manfredi*. *Hakomori* is relied upon for teaching "a plurality of dressing tools," but it does not makeup for the above-mentioned deficiencies in *Manfredi*. Thus, *Hakomori* cannot teach or suggest all the features of the present invention. As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met.

As pointed out in M.P.E.P. § 2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicants respectfully assert that claim 4 is distinguishable over the applied art and the rejections under 35 U.S.C. § 103(a) should be withdrawn because neither *Manfredi* nor *Hakomori* teaches or suggests each and every feature of claim 4.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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